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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,011	01/09/2001	Vassil Iliya Ognyanov	317743-103C	7091

25561 7590 05/20/2003

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/20/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/757,011

Applicant(s)

OGNYANOV et al.

Examiner

Brenda Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 26, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 43-74 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

Claims 43-74 are pending in the application.

This action is in response to applicants' amendment dated February 26, 2003. Claim 62 has been amended.

#### ***Response to Arguments***

Applicants' arguments filed February 26, 2003 have been fully considered with the following effect:

1. With regards to the 35 USC § 112, first paragraph rejection of claims 43-45, 48-65 and 68-73 maintained in the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicants stated that "the claims need not be set forth using the same terms used in the specification" and that "the practical flexibility of the description requirement extends to allowing the invention to be claimed in words that set forth the concepts found in an application, even though those specific words are not found in the specification". The instant application is not such that the claims recite a definition for the third bridging moiety in words other than those described in the specification, but the claimed subject matter is never described in the specification at all. The applicants point to compound A15 on page 24 of the specification for support of the genus as claimed herein, however, the species of example A15 is not even embraced by the claims, where the proviso limits the compounds such that "at least one of  $R^{xa}$ ,  $R^{ya}$ ,  $R^q$ ,  $R^r$  or  $R^s$  is heteroaryl, or a second bridge between  $R^{xa}$  and  $R^{ya}$  comprises sulfur or oxygen as set forth below, or Ar substituted with a methylenedioxy".

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Claims 43-45, 48-65 and 68-73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For reasons of record and stated above.

2. With regards to the 35 USC § 112, first paragraph rejection of claims 43-45, 48-65 and 68-73 of the last office action, the applicant's arguments have been fully considered but are not found persuasive. For reasons stated above with respect to the definition of  $R^{xa}$  and  $R^{ya}$ .

Claims 43-45, 48-65 and 68-73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For reasons of record and stated above.

3. The applicant's amendments are sufficient to overcome the 112 second paragraph rejections of the last office action which are hereby **withdrawn**.

4. With regards to the 35 U.S.C. 102 anticipation rejection of claims 43-74 of the last office action, the applicant's arguments have been fully considered but are not found persuasive. As stated above the instant claims are not described in the instant application and thus are only entitled to benefit of serial number 09/757,011 filed January 9, 2001 as it is only completely

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described in the instant application. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120.

Claims 43-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Ognyanov et al., WO 97/45115. For reasons of record and stated above.

### *Specification*

5. The abstract of the disclosure is objected to because the holes punched in the page to insert into the file go through the text. Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: pages 23 and 25-27 contain hand written notations on each page.

Appropriate correction is required.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman  
Primary Examiner AU 1624  
May 16, 2003